UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,693	12/01/2000	Paul E. Jacobs	PA000384	5519

23696	7590	04/16/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 December 2000</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-51</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-51</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>11</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-51 are presented for examination.

2.   This communication is in response to communication filed on 02/13/2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-4, 9-10, 15-17, 23-25, 27-30, 33-34, 41-48 and 50 are rejected under

35 U.S.C. 102(b) as being anticipated by Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 1, 15, and 33, Marsh teaches a method for operating a

client device that is configured for communications via a communications network

(Abstract). Effecting an advertisement download communication link between the client

device and an advertisement distribution server system, via the communications

network, at selected advertisement download times (see figure 4 and col. 3, lines 28-

37); effecting a data communication link with a data communications service provider,

via the communications network, wherein the advertisement download communication

link and the data communication link are separate communication links (Figure 4);

downloading advertisements from the advertisement distribution server system via the

advertisement download communication link (Figure 4); storing downloaded

advertisements on a storage medium associated with the client device (col. 14, lines 1-

10); displaying at least selected ones of the stored advertisements, in accordance with

ad display parameters prescribed by the advertisement distribution server system

(Figure 6, 702).

With respect to claims 2, 16-17 and 45, Marsh further teaches that the method is

installed on the client system and the advertisement distribution server system is

controlled by a vendor of the software (col. 3, lines 12-56).

With respect to claims 3 and 49, Marsh further teaches that the communication

network comprises the Internet (Figure 1 and col. 6, lines 16-29).

With respect to claim 4, Marsh further teaches that the software is subsidized by

revenues attributable to the downloaded advertisements (col. 3, lines 66-, col. 4, lines 1-

6).

With respect to claims 9-10, Marsh further teaches that the advertisements

include main screen advertisements and toolbar advertisements (Figure 4).

With respect to claims 23-25, Marsh further teaches that the display parameters

specify for each ones of the advertisements, how many times the advertisement is to be

displayed for a given time period, and how long that advertisement is to be displayed

each time that it is displayed (col. 3, lines 28-37).

With respect to claims 27-30, Marsh further teaches that the ad display

parameters specify, the total/cumulative amount of time that advertisements are to be

displayed (col. 3, lines 28-37).

With respect to claim 34, Marsh further teaches generating a cookie containing

information describing user/client device behavior and user demographics (col. 14, lines

66-, col. 15, lines 1-7); and transmitting the information to the at least one playlist server

(Figure 8 and col. 15, lines 10-20).

With respect to claims 41-44, Marsh further teaches a playlist customized based

on the user demographics and/or user device behavior col. 3, lines 12-27).

With respect to claims 46-48, Marsh further teaches that the software is e-mail

Software (see Figure 8).

With respect to claim 50, Marsh further teaches that the display of the at least

ones of the stored advertisements comprises displaying the at least selected ones of

the stored advertisements when the client device is offline (col. 6, lines 63-, col. 7, line

1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 5-8, 11-14, 18-22, 26, 31-32, 35-40 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 5-8, 11-12, 26, 31-32 and 51, Marsh further teaches the maximum time that the associated advertisements is to be displayed each time that it is displayed (col. 3, lines 28-37 and col. 14, lines 66-, col. 15, lines 1-20); the maximum cumulative time that the associated advertisement is to be displayed (col. 3, lines 28-37 and col. 14, lines 66-, col. 15, lines 1-20).

With respect to the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed. Official notice is taken that it is old and well known in advertisements/marketing to make certain determinations such as the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed in order to target the correct time when the advertisements should be displayed and the right time that the advertisements should not be displayed in order to better target the correct time for the advertisements.

Claim 13 further recites displaying at least ones of the advertisements in a linear manner. Official notice is taken that it is old and well known to display in a linear

manner in order to provide an output that is proportional. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites displaying at least ones of the stored advertisements in a linear manner in order to achieve the above mentioned advantage.

Claim 14 further recites displaying at least ones of the advertisements in a random manner. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the advertisements in a random manner in order to obtain the above mentioned advantage.

With respect to claims 18-22, 35-40, Marsh further teaches at least one of the ad display parameters is a face time duration parameter that specifies a face time duration for at least one of the stored advertisement (col. 3, lines 28-36) and the step of displaying at least selected ones of the stored advertisements comprises displaying the at least one of the stored advertisements for the face time duration prescribed by the associated face time duration parameter (col. 3, lines 28-36).

With respect to the face time duration comprising a time period during which at least a prescribed minimum level of user activity is detected. Since Marsh teaches maintaining information on the user activity and interactivity with the advertisements (col. 14, lines 66-, col. 15, lines 1-7) then it would have been obvious to a person of ordinary skill in

the art at the time of Applicant's invention to have included using the user activity of

Marsh to determine the face time duration of the advertisements during which at least a

prescribed minimum level of the user activity is detected because such a modification

would help in determining and better targeting the ads based on the user's activity.

Response to Arguments

5.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., two different servers) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993). Even if two servers were claimed, Marsh teaches on Figure 8, 2 different

servers 107 and 108 connected to server subsystem 104, a user using client computer

101 can access information from server 107 or 108.

6.   Applicant argues that Marsh doesn't teach a data communication link and an

advertisement communication link being separate links. In Marsh, the user can access

the e-mail without accessing the advertisements. The user makes a first

communication link to access the e-mail and then in order to access the

advertisements, the user makes a second communication link by clicking on the

advertisements, which is a separate link from the first communication link (col. 7, lines

57-65).

7.   With respect to the arguments of claims 5-8, 11-14, 18-22, 26, 31-32 and 35-40,

Applicant argues that Marsh doesn't teach that the advertisement communication link

and the data communication link are two separate links. As explained above, In Marsh,

the user can access the e-mail without accessing the advertisements. The user makes

a first communication link to access the e-mail and then in order to access the

advertisements, the user makes a second communication link by clicking on the

advertisements, which is a separate link from the first communication link (col. 7, lines

57-65).

8.   Applicant argues that managing advertisement scheduling display wherein the

system manages the times per day and the day/time in which the advertisement should

be and should not be displayed is not well known in advertisements/marketing. The

Examiner respectfully disagrees with Applicant. First of all, the Applicant agrees that

Marsh teaches and tries to solve the problem of advertisers "run the risk of users being

numbered or otherwise negatively affected by their advertising as a result of

overexposure" . Therefore in the system of Marsh scheduling the display of when and

not to display ads is very important and would have been obvious to monitor and deliver

the right amount of advertisements to avoid "overexposure". In addition, the Examiner

is providing a reference to support the official notice taken that managing when the

advertisements should be or not displayed based on the time/day. Aggarwal et al.

(6,714,975) teaches a method for targeted advertising on the web. Displaying and

managing different advertisements depending upon the time of the day (col. 3, lines 36-

42).

9.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., the software provider or the client software cognizant of the content of any

particular ad that the user is looking at and requesting them in real time) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10.   Applicant argues that Marsh doesn't teach displaying an advertisement for a face

time duration. The Examiner respectfully disagree with Applicant because Marsh

further teaches on col. 8, lines 47-54 and col. 9, lines 41-49 lines that the

advertisement display scheduler 700 controls the amount of time that an advertisement

is presented to the user to avoid overexposure. With respect to time duration of the

advertisements based on user's activity. The Examiner wants to point out that Marsh

clearly teaches on col. 15, lines 2-9 **"each time a new banner advertisement is**

displayed, for example, the advertisement display scheduler 700 updates the log

file with the identification of the banner advertisement, the time and date it was

displayed, and the duration of the display. This information is then used by the

advertisement display scheduler 700 in determining which advertisements to

display subsequently" given the facts that Marsh teaches displaying an

advertisement for a face time duration to avoid overexposure and logging and recording

the user's interaction with the advertisements which correspond to the time duration of

the display (as explained above) then it would have been obvious to have included

determining subsequent face duration of the advertisements based on the user activity.

Conclusion

11.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Point of contact

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Raquel Alvarez whose telephone number is (703)305-

0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
4/15/04